

## REMARKS/ARGUMENTS

### Claim Rejections 35 U.S.C. §102

Claims 1-4, 6-12 and 16-20 are rejected, under 35 U.S.C. §102(b), as being allegedly anticipated by Iwata et al. (US Patent No. 6,009,338) (hereinafter Iwata). Applicants respectfully traverse in view of the following.

Independent Claim 1 recites a sliding component operable to change the size of a dimension of the portable electronic device, e.g., length, by sliding relative to said processor module, as claimed. Thus, the size of the electronic device may be contracted or expanded. Independent Claim 1 further recites that the sliding component is operable to accept at least one button input from a user, as claimed. For example, the sliding component may include a softbutton key, mechanical button key, etc. Moreover, independent Claim 1 recites that a device driver performs an action based on a selection of information displayed on the display, wherein the selection is based on the position of said edge relative to said displayed information, as claimed.

In contrast, Iwata discloses a location detector for detecting a location of the slider cover for changing the size of the display (see Iwata, col. 5, lines 55-57). The slider cover of Iwata slides within the rails on the sides of the electronic device without extending beyond the top or the bottom of the electronic device

(see Iwata, Figures 47-49, 51-53 and 56, elements 301, 302, 304, 305 and 314). Accordingly, the length of the electronic device cannot be extended or contracted. Accordingly, the size of the electronic device remains the same, as disclosed by Iwata. Thus, Iwata fails to either teach or suggest a sliding component operable to change the size of a dimension of the portable electronic device by sliding relative to said processor module, as claimed.

Moreover, Iwata discloses that the structure of a cover for protecting an input display unit for a portable electronic apparatus (see Iwata, col. 1, lines 17-20). Iwata further discloses that the slider cover slides and that the location detector detects a location of the slider cover (see Iwata, col. 5, lines 55-56) by employing a cover switch to detect a location of the cover, thereby detecting an open/close status of the cover (see Iwata, col. 12, lines 47-53). The slider cover has no electronic components to enable a user input (see Iwata, Figures 7-49, 51-53 and 56). Accordingly, the slider cover, as disclosed by Iwata serves as a protective shield for the electronic apparatus. Thus, Iwata fails to either teach or suggest that the sliding component is operable to accept at least one button input from a user, as claimed.

The rejection asserts that the sliding display cover in Figures 47 and 48 is inherently considered as an input device. Applicants respectfully traverse in view of the following.

Applicants wish to remind the Examiner that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient (see *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art (see *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

As discussed and presented above, the slider cover, as disclosed by Iwata, serves as a protective shield not as an input device of any kind. Moreover, as discussed and presented above, there are no electronic component on the slider cover. Applicants fail to see why having a protective shield like the slider cover, as disclosed by Iwata, would necessarily be operable to accept at least one button input from a user, as claimed as alleged by the rejection. Thus, withdrawal of the rejection based on inherency is earnestly requested.

Moreover, Iwata discloses that in transitioning from a telephone mode (closed) to an information mode (open), the screen displays either historical information, a talk log or a user setting screen (see Iwata, Abstract). Iwata further discloses that displaying this information enables the user to obtain the desired screen with a fewer number of operations and with less waiting time (see Iwata, Abstract). When the sliding cover is in a closed position (telephone mode), the information terminal mode is inactive and vice versa. Thus, when the sliding cover is closed no information can be selected since the device is not in information terminal mode. Thus, Iwata fails to either teach or suggest that a device driver performs an action based on a selection of information displayed on the display, wherein the selection is based on the position of the edge relative to the displayed information, as claimed.

Accordingly, Iwata fails to anticipate independent Claim 1, under 35 U.S.C. §102(b). Independent Claims 8 and 16 recite limitations similar to that of independent Claim 1 and are patentable for similar reasons. Dependent claims are patentable by virtue of their dependency.

As per Claim 2, the rejection asserts that a display switch for changing the size of the display area is considered as the action for visual configuration. Applicants respectfully disagree. Resizing a display merely changes the size of the display and not necessarily visual configuration of data rendered on the

display, as claimed. For example, changing the size may merely not display items that may be covered by the sliding cover. Thus, resizing the display, as disclosed by Iwata, does not necessarily teach or suggest visual configuration of data rendered on the display, as claimed.

As per Claim 3, Iwata discloses a cover that rotateably opens/closes (see Iwata, Figure 59) by making contact with a cover switch (see Iwata, col. 1, lines 43-45 and Figure 59, element 9). Iwata discloses that a telephone keyboard may be used for dialing and that the telephone mode is used when the cover is closed (see Iwata, col. 1, lines 42-47). Accordingly, Figure 59, as disclosed by Iwata, fails to either teach or suggest an action based on a selection of an information displayed on the display based on the position of the edge relative to the displayed information, as claimed in the independent Claim 1.

Referring still to Claim 3, Applicants respectfully submit that the embodiment of the rotateable cover is different than embodiment of a sliding cover, as shown in Figures 47-49, 51-53 and 56 of Iwata (see Iwata, Figures 47-49, 51-53 and 56). Applicants wish to remind the Examiner that anticipation requires the disclosure in a single prior art reference of each claim under consideration (see *W.L. Gore & Assocs. v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art

reference must disclose each element of the claimed invention “arranged as in the claims” (see *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)). Accordingly, choosing various elements from different embodiments (e.g., Figure 59 and Figures 51-53) fails to teach the recited limitations in the arranged claimed fashion. Claim 4 recites limitations similar to that of Claim 3 and is patentable under similar rationale.

As per Claim 7, Iwata discloses a sliding cover that acts as a protective shield for the electronic component, as presented and discussed above. Thus, Iwata fails to either teach or suggest that the signal is initiated from the sliding component by pressing on an input key residing on the sliding component, as claimed.

As per Claim 11, Iwata discloses a first and a second software that share information for a telephone operation (see Iwata, col. 7, lines 33-35). Iwata further discloses a third piece of software that enables access to the shared information (see Iwata, col. 7, lines 36-38). Iwata discloses that the electronic device may be used as a telephone when the door is in a closed position (see Iwata, col. 7, lines 39-43). Sharing of information between the first and the second software and getting access to the shared information using a third piece

of software, as disclosed by Iwata, fails to either teach or suggest a display of related additional information for the portion of the information, as claimed.

As per Claim 12, Iwata discloses a switch that is used to detect the close/open position of the sliding cover (see Iwata, col. 12, lines 48-53 and Figure 2). Detecting a close/open position of a sliding cover, as disclosed by Iwata, fails to either teach or suggest selecting a portion of the information via a key, as claimed.

As such, allowance of Claims 1-4, 6-12 and 16-20 is earnestly solicited.

#### Claim Rejections 35 U.S.C. § 103

Claims 5, 13 and 15 are rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Iwata. Applicants respectfully traverse in view of the following.

Claim 5 depends from independent Claim 1 and is patentable at least by virtue of its dependency. Similarly, Claims 13 and 15 depend from independent Claim 8 and are patentable by virtue of their dependency.

Regarding Claims 13 and 15, the rejection takes Official Notice that features such as a sliding cover comprising a keyboard and a speaker, as

claimed, are well known in the art. Applicants respectfully disagree and assert that it is not appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based (see *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697). Moreover, Applicants respectfully submit that the rejection must point to some concrete evidence in the record in support of these findings to satisfy the substantial evidence test (see MPEP 2144.03(c)). If the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding (see 37 CFR 1.104(d)(2) and MPEP 2100-144).

Moreover, Applicants respectfully submit that even if these features are well known, one would not be motivated to modify the teachings of Iwata because as discussed and presented above Iwata teaches that the sliding cover is a protective shield structure for protecting the input display unit and other electronics. A cover with exposed electronic components therein contradicts the motivation of Iwata to protect electronic components (e.g., speaker and keyboard) and renders the protective shield structure of Iwata inoperable for its intended purpose. As such, allowance of Claims 13 and 15 is earnestly solicited.



Claim 14 is rejected, under 35 U.S.C. §103(a), as being allegedly unpatentable over Iwata in view of Hansen et al., (U.S. Patent No. 5,956,625) (hereinafter Hansen). Applicants respectfully traverse in view of the following.

Claim 14 depends from independent Claim 8 and is patentable over Iwata by virtue of its dependency. Moreover, Hansen fails to teach or suggest the limitations of independent Claim 8. As such, Claim 14 is patentable over the combination of Iwata and Hansen by virtue of its dependency.

Moreover, the rejection admits that Iwata fails to teach that the sliding cover includes a microphone, as claimed. The rejection relies on Hansen to remedy this failure. As discussed and presented above, a cover with exposed electronic components therein contradicts the motivation of Iwata to protect electronic components (e.g., microphone) and renders the protective shield structure of Iwata inoperable for its intended purpose. As such, one would not be motivated to combine Iwata and Hansen in the claimed fashion. As such, allowance of Claim 14 is earnestly solicited.

For the above reasons, Applicants request reconsideration and withdrawal of these rejections under 35 U.S.C. §102 and 35 U.S.C. §103.

### CONCLUSION

In light of the above listed remarks, reconsideration of the rejected claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1-20 overcome the rejections of record and, therefore, allowance of Claims 1-20 is earnestly solicited.

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Respectfully submitted,  
MURABITO, HAO & BARNES LLP

A handwritten signature in black ink, appearing to read 'A. A. Tabarrok', is written over a horizontal line.

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